

### **REMARKS**

Claims 1 and 6 have been amended to incorporate the limitations of dependent claims 26 and 27, respectively. Claim 28 has been amended to correct a minor informality. Claims 14-18, 26, 27, and 30 have been cancelled. Claims 1-13, 19-25, 28, 29, and 31 are therefore pending and are presented for review. Favorable reconsideration and allowance are requested in light of the foregoing amendments and the remarks which follow.

Claims 14-18, and 30 stand rejected over the prior art. These claims have been cancelled without disclaimer or prejudice, hence mooted the rejection of those claims.

#### **1. Objection to Amendments to Specification Under 35 U.S.C. §132**

The objection to the December 8, 2003 amendment under 35 U.S.C. §132, as introducing new matter into the disclosure of the invention is respectfully traversed because the original specification does, in fact, support the amendment that is considered new matter by the Examiner. More specifically, in the Office Action the Examiner states that the specification does not support the added material "...without mixing the single liquid with any other substances..." that was added to claims 1, 6, and 19. In making this claim, the Examiner states that there is no support in the specification of the application to support the claimed subject matter directed to use of the inventive system with a single liquid.

It is a well established tenet of patent law that exact claim terms need not be used in haec verba to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112. *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976). *See also* 37 CFR 1.121(a)(5) which merely requires substantial correspondence between the language of the claims and the language of the specification. MPEP 2163.01-02. Despite the lack of an exact recitation of the subject limitation, based on the inherent implications of the disclosure, one of ordinary skill in the art, when reading the disclosure and claims in context, would clearly understand the subject characteristic of the disclosed system and process as supported by the specification. Throughout

the specification, reference is made to the dispensing of a single liquid, for example, such as “beer or soda.” (Pg. 1, Ln. 18). Other than the purely descriptive reference to “a mixing rod restrictor” in describing component parts of the inventive system, Applicant makes no reference, explicit or implicit, to the inventive system as being directed to or including anything other than the dispensing of a single liquid. To the contrary, the drawings clearly illustrate a system in which a single liquid is directed through a restrictor without being mixed with any other substances. Note in this regard that Fig. 1 unequivocally illustrates a restrictor 18 having a single inlet receiving liquid from a pump 124. There is no hint whatsoever of mixing that liquid with any other substance prior to discharging the liquid from the restrictor. The same can be said for the restrictor 318 of Fig. 5.

Therefore, applicant believes that the amendments adding the limitation “without mixing the single liquid with any other substances” is in fact supported by the original specification such that the limitation does not constitute new matter. As a result, applicant respectfully requests that the Examiner withdraw the objection to the December 8, 2003 amendment.

**2. 35 U.S.C. §102(b)**

The rejection of claims 1-11, 19-24, 26-29, and 31 under 35 U.S.C. §102(b) as being anticipated by Belser et al. U.S. Patent No. 5,480,589 (the ‘589 patent) is respectfully traversed, because, inter alia, claims 1 and 6 as amended and claim 28 include limitations not shown or discussed in the ‘589 patent and claims 19 and 31 disclose novel methods not shown or discussed in the ‘589 patent.

**a. Apparatus Claims 1-11, 28 and 29**

Claims 1 and 6 as amended to include the limitations of dependent claims 26 and 27, respectively, and claim 28 require “a housing having a single inlet.” In contrast, the ‘589 patent discloses a mixer 3 that receives material and gas, respectively from a bulk material source 22 and a gas supply 24. Therefore, unlike the claimed invention, the ‘589 patent discloses a housing

having two inlets. The '589 patent fails to disclose a liquid dispensing system with a housing having a single inlet. To the contrary, the mixer 10 must necessarily have *two* inlets to permit the supply of the gas and the resinous materials from the sources 22 and 24, respectively. Hence, even if a pressure drop is inherent in Belser's system, claims 1, 6, and 28 are not anticipated.

Moreover, the functional limitation of imparting directional changes to the single liquid "without mixing the single liquid with any other substances" clearly *cannot* be met by Belser because Belser *must* mix the liquid with other substances. The Examiner is reminded in this regard that functional language cannot be ignored and that a device that is *incapable* of performing the claimed function cannot anticipate a claim. *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). In light of the foregoing, Applicant respectfully requests the withdrawal of the rejection of claims 1, 6, and 28.

Even if the new matter objection was proper (which it is not), the Examiner should still consider the disputed limitations when determining whether the claims are allowable over the prior art:

If new subject matter is added to the disclosure, whether it be in the abstract, the specification, or the drawings, the examiner should object to the introduction of new matter under 35 U.S.C. 132 or 251 as appropriate, and require applicant to cancel the new matter. If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement. *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981). ***The examiner should still consider the subject matter added to the claim in making rejections based on prior art since the new matter rejection may be overcome by applicant.***

MPEP 2163.06 (Emphasis Added).

Claim 28 additionally requires that the liquid dispensing system be one for dispensing a liquid having an entrained gas, such as a carbonated beverage. Hence, it specifically requires that the source be configured to dispense a liquid having gas entrained therein. Any anticipating structure must at least be *capable* of functioning as claimed. *In re Schreiber*, 44 USPQ2d 1429

(Fed. Cir.1997). Belser's resin dispenser 22 is incapable of dispensing a liquid having an entrained gas. The rejection of claim 28 must be withdrawn for this additional reason.

Dependent claims 2-5, 7-11, and 29 are believed to be in condition for allowance for incorporating by reference the limitations of claims 1, 5 and 28 and for defining additional features of the invention, which, when considered in combination with those of the associated independent claims, are neither disclosed nor suggested by the prior art relied upon in the rejection. For instance, with reference to claims 10 and 11, the Examiner has failed to identify flow divider bar or a flow straighter in Belser.

In light of the amendments and the foregoing, withdrawal of the rejection of claims 1-11, 28 and 29 is respectfully requested.

**b. Method Claims 19-24 and 31**

Claims 19 and 31 are directed to a method of reducing liquid pressure of a single liquid, and a method of dispensing a carbonated beverage respectively. As noted previously, the '589 patent discloses a foam mixing system, not a pressure reducing system or a carbonated beverage dispensing system. Unlike applicant's claimed method which is directed to reducing pressure of a single liquid, the Belser device is used to mix multiple components from multiple sources. See FIG. 2. Belser does not disclose or make any reference to a method of reducing liquid pressure of a single liquid or a method of dispensing a carbonated beverage.

Applicant's invention as recited in method claims 19-24 does not mix, nor involve the mixing of, any liquids, gases, or other components. Claim 19 specifies that the restrictor housing receives a *single* liquid. In addition, claims 19 specifies that that the pressure drop takes place without mixing the single liquid with any other substance. In sharp contrast, *the entire* purpose of Belser's device is to mix *two* materials to produce a foam.

## 1. Examiner's Response to Amendment

In the Examiner's *Response to Amendment*, the Examiner has improperly suggested that Applicant's method claims are inherently anticipated by the '589 patent. Applicant notes, however, that despite any inherent properties of the apparatus disclosed in the '589 patent, it is a well established principle that a new use for a known composition or device is patentable. *In re Zierden*, 411 F.2d 1325, 56 CCPA 1223 (1969); *Catalina Marketing Int'l, Inc. v. Coolsavings.com, Inc.* 289 F.3d 801 (Fed. Cir. 2002). For instance, in *Catalina Marketing*, the Court sated:

Perhaps a hypothetical best illustrates these principles: Inventor A invents a shoe polish for shining shoes (which, for the sake of example, is novel, useful, and nonobvious). Inventor A receives a patent having composition claims for shoe polish. Indeed, the preamble of these hypothetical claims recites "a composition for polishing shoes." Clearly, Inventor B could not later secure a patent with composition claims on the same composition because it would not be novel. *See In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Likewise, Inventor B could not secure claims on the method of using the composition for shining shoes because the use is not a "new use" of the composition but, rather, the same use – shining shoes. *See Bristol-Myers*, 246 F.3d at 1375; *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). S

Suppose Inventor B discovers that the polish also repels water when rubbed onto shoes. Inventor B could not likely claim a method of using the polish to repel water on shoes because repelling water is inherent in the normal use of the polish to shine shoes. *Id.* at 1326 ("[I]f a previously patented device, in its normal and usual operation, will perform the function [claimed] in a subsequent [ ] process patent, then such [ ] process patent [is] . . . anticipated by the former patented device.") (quoting *In re Ackenback*, 45 F.2d 437, 439, 7 USPQ 268, 270 (CCPA 1930)); *see also Bristol-Myers*, 246 F.3d at 1375. In other words, Inventor B has not invented a "new" use by rubbing polish on shoes to repel water. Upon discovering, however, that the polish composition grows hair when rubbed on bare human skin, Inventor B can likely obtain method claims directed to the new use of the composition to grow hair. *See* 35 U.S.C. § 101 (1994) ("Whoever invents or discovers any new and useful process ... may obtain a patent therefor."); 35 U.S.C. § 100(b) (1994)

("The term 'process' means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.").

Catalina Marketing, at 809-810.

The facts of the present case are indistinguishable from those in the last example in *Catalina Marketing*. The device in question, even if old, is being used for a purpose other than intended by the Belser reference to obtain a result not intended by Belser. Patentability therefore must lie. Were that not the case, methods could never be patented unless they utilized a novel and non-obvious device or composition. That clearly is not the law. In light of the foregoing, withdrawal of the rejection over the '589 patent is respectfully requested.

Dependent claims 20-24 are believed to be in condition for allowance for incorporating by reference the limitations of claim 19 and for defining additional features of the invention, which, when considered in combination with those of the associated independent claims, are neither disclosed nor suggested by the prior art relied upon in the rejection.

Claim 31 claims a method of dispensing a carbonated beverage, thereby requiring that the liquid be a carbonated beverage. As should be clear from the foregoing, the Examiner cannot predicate a rejection based on anticipation by alleging that Belser's device would be *capable* of operating as claimed *if* placed in a carbonated beverage dispensing system. The system as disclosed in Belser, *when used in its intended fashion*, must anticipate the method, either expressly or inherently. It does not. To the contrary, Belser's foam production system is *utterly incapable* of dispensing a carbonated beverage.

In light of the amendments and the foregoing, withdrawal of the rejection of claims 19-24 and 31 is respectfully requested.

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### **3. Allowable Subject Matter and Conclusion**

In the previous office action mailed October 3, 2003, the Examiner noted the allowability of claims 12, 13, and 25 if rewritten in independent form. Applicant received this suggestion with appreciation and in the response to the October 3, 2003 office action, Applicant rewrote claims 12 and 25 in independent form including all of the limitations of the base claim and any intervening claims. No new matter was added in rewriting claims 12 and 25. Claim 13 depended from claim 12 and was thus patentable based on the limitations contained therein as well as those in the base claim. Applicant believes the Examiner's reiteration of these comments was in error in light of the previous amendments and therefore believes in light of the Examiner's remarks, claims 12, 13 and 25 are allowable.

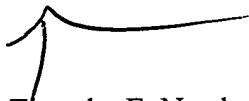
It is therefore submitted that claims 1-13, 19-25, 28, 29 and 31 are in compliance with 35 U.S.C. §102 and §132 and each define patentable subject matter. A Notice of Allowance is therefore respectfully requested.

Enclosed is a check for \$55 which includes the government filing fee by a *small* entity for a one-month extension of time, which applicant hereby requests. No additional fee is believed to be payable with this communication. Nevertheless, should the Examiner consider any other fees to be payable in conjunction with this or any future communication, the Director is authorized to direct payment of such fees, or credit any overpayment to Deposit Account No. 50-1170.

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In view of the foregoing amendments and remarks, the application is believed to be in prima facie condition for allowance, and such action is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it would help expedite matters.

Respectfully submitted,



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